



PATENT
P57623

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

WERNER HONEGGER

Serial No.: 10/660,783

Examiner: MORRISON, THOMAS A.

Filed: 12 September 2003

Art Unit: 3653

For: A METHOD AND A DEVICE FOR PROCESSING AND SEPARATING AN IMBRICATE FORMATION OF FLEXIBLE, FLAT OBJECTS

Paper No. 19

**PETITION UNDER 37 C.F.R. §1.144
TO WITHDRAW A RESTRICTION REQUIREMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petitions the Commissioner, under 37 CFR §1.144, to overrule the Examiner's decision to impose a restriction requirement in this application.

Folio: P56949
Date: 11/23/07
I.D.: REB/kf

STATEMENT OF FACTS

1. On 27 January 2006, the Examiner mailed a restriction requirement (Paper No. 012006), requiring restriction between Group I covered by claims 1-16, drawn to a method for processing and separating imbricate formation of flexible flat objects, classified in class 271 and subclass 3.01; Group II covered by claims 17-25, drawn to a guide, classified in class 271 and subclass 264; and Group III covered by claims 26-31, drawn to a guiding method, classified in class 271 and subclass 264..
2. On 27 February 2006, Applicant filed a response to the restriction requirement, in which Group I was provisionally elected **with traverse**.
3. On 30 May 2006, an Office action was mailed (Paper No. 051506), in which Office action Applicant's provisional election with traverse of Group I was acknowledged, the restriction requirement was made final, and claims 17 through 31 became withdrawn from consideration.
4. On 20 February 2007, Applicant filed a Second Substitute Amendment (Paper No. 14) in which claims 1 through 31 were canceled and claim 32 through 62 were newly presented.
5. On 22 May 2007, a final Office action was issued (Paper No. 20070510). In the final Office action in which the Examiner maintained the restriction requirement of 27 January 2007, and stated that the newly presented claims 48 through 62 appeared to correspond to previous claims 17 through 31, which had been withdrawn from further consideration. As a result, of all pending claims 32 through 62, claims 48 through 62 are withdrawn from consideration.

ARGUMENT

Applicants respectfully renew their traverse of the requirement imposed pursuant to 35 U.S.C. §121 and 37 CFR §1.142, and pursuant to 37 CFR §1.144 request reconsideration and withdrawal of the restriction requirement, and examination of all of the claims 32 through 62, inclusive, pending in this application.

In Paper No. 012006 mailed on 27 January 2006, the Examiner imposed a restriction between:

- Group I covered by claims 1-16, drawn to a method for processing and separating imbricate formation of flexible flat objects, classified in class 271 and subclass 3.01;
- Group II covered by claims 17-25, drawn to a guide, classified in class 271 and subclass 264;
- Group III covered by claims 26-31, drawn to a guiding method, classified in class 271 and subclass 264.

Applicant provisionally elects, with traverse, Group I drawn to a method for processing and separating imbricate formation of flexible flat objects, classified in class 271 and subclass 3.01, with traverse. Claims 1 through 16 are within the elected Group I.

Applicant objected to the imposition of the requirement for restriction requirement on the following grounds.

First, the subject matter of the three groups overlap. In addition, the mandatory fields of search for the three embodiments are substantially coextensive. Moreover, the Examiner has stated that the invention of claims 1 through 16 are classified in Class 271, Subclass 3.01,¹ and that the invention of Group II, claims 17 through 25 and that the invention of Group III, claims 26 through 31 are also both classified in Class 271, although at Subclass 264,² it is submitted that, in order to perform a comprehensive search, the mandatory field of search for elected

¹ Delivering To Stack And Feeding Therefrom

² Feeding ... By means to convey sheet (e.g., from pack to operation).

Group I must include Class 271, subclass 264 because subclass 264 is a breakout of subclass 8.1;³ the field of mandatory search of Group I includes subclass 3.14⁴ as well as subclass 8.1, and their various breakouts.⁵ The attention of the Examining staff is invited to note that although the main classifier of subclass 3.01 is a *stack*, a feature which is not recited *per se* by Applicant's independent claims 32, 48, 51, 57 or 60 (or, for that matter, by any of Applicant's pending claims 32 through 62); all of Groups I, II and III do however, recite common features (*e.g., guiding*) which are common to the 3.14 and 8.1 subclasses. Thus, the mandatory fields of search necessarily overlap and are substantially coextensive for all three of the groups of claims, and therefore the restriction requirement serves no purpose other than to impose an undue burden and unnecessary expense upon the Applicants (*see MPEP §802.01, §806.04, §808.01*). There would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits.

Second, rising to level of a *serious* burden is seriously suspect, especially in light of the generic claims involved. It appears that the restriction requirement is being imposed here merely for administrative convenience, and such a basis for imposition of a restriction requirement has been prohibited in previous decisions of the Commissioner.

As specifically stated in *Manual of Patent Examining Procedure*, 8th Edition, Revision 6 (September 2007), §803, in imposing a restriction requirement, the Examiner must show that: (A) the inventions are independent (*see also MPEP §802.01, §806.04, §808.01*) or distinct as claimed (*see further MPEP §806.05 - §806.05(i)*); and (B) there will be a serious burden on the Examiner if the restriction requirement is not imposed (*see MPEP §803.02, §806.04(a)* -

³ Feeding ... By means to convey sheet (*e.g.,* from pack to operation).

⁴ Feeding And Delivering.

⁵ The Examiner's classification of Group I is suspect because claim 1 does not define either a *stack* or *delivering to a stack* or *feeding from a stack*. Applicant submits therefore, that the mandatory field of search from all three group both main subclasses 3.14 (*Feeding And Delivering*) and 8.1 (*Feeding*), as well as several of their respective breakout subclasses.

§806.04(i), §808.01(a), and §808.02). It is respectfully submitted that in an examination of the above-captioned application, there would not be a serious burden upon the Examiner in searching the invention of Groups I, II and III because the Examining staff has failed to show any type of burden, much less a serious burden, in the absence of a restriction requirement. In particular, not only has the Examiner failed to show that the search would impose a burden, but also the Examiner has failed to show that any burden would rise to the level of a serious burden. As stipulated in MPEP §803, if the search can be made without serious burden, the Examiner must examine the application on the merits, even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in the Office action mailed on 12 January 2006 (Paper No. 20060106) and thus the Examiner must examine the entire application. Moreover, because no burden was shown, if the restriction is not withdrawn in the next Office action, the restriction requirement can not be made final according to MPEP §706.07. Therefore, there would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits.

Third, *MPEP* §806.03 states that:

“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition” (emphasis supplied).

Why, then has this prohibition been violated in the above-captioned application where a single embodiment has been disclosed?

Here, Applicant discloses but a single embodiment. That fact that Applicant’s claims are very broad in scope, and may cover a plethora of implementations of the principles of Applicant’s inventions, is not a basis for violating this prohibition against restriction. Withdrawal of this requirement is therefore respectfully urged.

Fourth, in the final Office action, the Examiner justified maintenance of the requirement by arguing that newly presented claims 48 through 62 “appear to correspond with previously

presented claims 17-31.” Aside from the fact that such correspondence is an arithmetic impossibility, there is no analysis given to support the Examiner’s conclusion. In point of fact, the language of each of independent claims 32, 48, 51, 57 and 60 tracks, with varying degrees of scope, the language of claim 32. Unexplained in Paper No. 20070510 is any consideration of either distinctiveness or independence in the subject matter covered by claims 48, 51, 57 and 60 in comparison with examined claims 32 through 47. Moreover, Paper No. 20070510 fails to justify the Examiner’s election of claims 32 through 47 as opposed to withdrawn claims 48 through 62, or to justify the Examiner’s denial of Applicant’s right to make and election.

The fact that the sole justification given in Paper No. 012006 for the requirement, was the Examiner’s naked averment that Group II was “drawn to a guide” and that Group III was “drawn to a guiding method.” In point of fact, both the subject matter of Group II is included within the text of elected Claim 32, while the subject matter of Group III, “drawn to a guiding method” is also included within the text of process Claim 32. Consequently, there is no justification in the prosecution history of the above-captioned application for maintaining this requirement. Its withdrawal is respectfully urged.

ACTIONS REQUESTED

Based on the above arguments, the following actions are respectfully requested:

- A. Overruling of the decision by the Examiner to impose a restriction requirement in this application;
- B. Reinstatement of all of the claims of the present application for examination and consideration by the Examiner; and
- C. Grant such other and further relief as justice may require.

Respectfully submitted,



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